

REMARKS/ARGUMENTS

By this Amendment, paragraphs [0009] and [0012] of the specification have been amended to adapt the description to the claims.

Claims 14, 17, 20, 25 and 28 have been amended to clarify the claimed subject matter.

Claim 26 has been amended to correct the dependency thereof.

Claims 19 and 27 have been amended to clarify that the rear, side elements and side panels, respectively, may be removed from the vehicle or lowered into the chassis. Support for this amendment is provided, e.g., in paragraph [0030] of the specification. Amended claim 16 finds support in the same location.

Claim 19 has also been amended to indicate that the rear window, rear pillars and rear segment are longitudinally displaceable as a unit, which is clear e.g., from Fig. 5 and paragraph [0033].

Claim 27 has also been amended (i) to introduce a new tailgate feature, which finds support, e.g., in paragraph [0028] and Fig. 2, and (ii) to clarify the engageability of the windshield frame to the rear roof part, which finds support, e.g., in paragraphs [0033]-[0034] and Fig. 5.

Additional support for claims 10-29 is provided by the specification and figures and can be identified, if necessary. No new matter is added by this Amendment and claims 10-29 remain pending for further examination.

In paragraph 2 of the non-final Office Action mailed November 2, 2007, claims 14, 17, 25 and 26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In response, claims 14, 17 and 25 have been amended as proposed by the Examiner.

In addition, claim 26 has been amended to be dependent from claim 19.

Therefore, it is believed that the Section 112 rejections have been overcome.

In paragraph 3 of the Office Action, claim 27 was objected to as being a substantial duplicate of claim 19.

In response, claim 27 has been amended to recite features not found in claim 19. Therefore, it is believed that the double patenting objection has been overcome.

In paragraph 5 of the Office Action, claims 10-11, 16-19 and 26-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Breitschwerdt et al. in view of King et al.

The Applicant respectfully traverses this obviousness rejection for the following reasons.

Breitschwerdt et al. disclose a convertible sedan, which includes a rear luggage space lid 18. Col. 4, lines 5-8 and Figs. 2 and 3. Thus, when driving with the displaceable section 3 displaced towards the rearward-most position, the rear luggage space lid 18 will necessarily bisect the interior space above and below the lid 18. Consequently, when the displaceable section 3 is in its rearward position, the interior space defined above the lid 18 and below the displaceable section 3 is useless.

In view of this design, the person of ordinary skill in the art would have had no motivation to provide a forward roof part and rear, side elements (or side panels) in accordance with pending claims 10, 19 or 27, because no particular purpose or object would be served by providing a fully closed passenger compartment with the displaceable section 3 in its rearwardly disposed position. In the absence of an obvious purpose or object for modifying the prior art, there would have been no motivation for the person of ordinary skill to have made such a modification.

Furthermore, if a removable forward roof part, hypothetically speaking, were to be added to Breitschwerdt et al., it would defeat the express purpose of the displaceable roof structure disclosed therein. That is, the exclusive reason for developing the displaceable roof structure of Breitschwerdt et al. was to provide an “open drive”, i.e. a convertible. See e.g., col. 1, ll. 16-20 of Breitschwerdt et al. If, on the other hand, the passenger compartment were to be fully enclosed with the displaceable roof structure disposed in its rearward-most position, then such a fully enclosed structure would not achieve the express purpose and object (i.e. to provide a convertible) of Breitschwerdt et al. Consequently, Breitschwerdt et al. teach away from the modification suggested by the Examiner.

In addition or in the alternative, as was noted above, the interior space behind the passenger compartment of Breitschwerdt et al. is physically divided by the rear trunk lid 18 when the displaceable roof section 3 is disposed in its rearward-most position. Thus, the interior space bounded by the lid 18 and the displaceable roof section 3 is useless. As such, hypothetically speaking, the installation of a forward roof part, when the displaceable roof section 3 is rearwardly disposed, would not provide any additional useful space, while simultaneously defeating the purpose of providing a convertible configuration, thereby further teaching away from the modification suggested by the Examiner.

In addition or in the alternative, it is noted that Breitschwerdt et al. teach a rear window 15 that is cranked up and down by conventional means. Col. 3, line 55 to col. 4, line 8. Thus, the rear window 15 of Breitschwerdt et al. is not displaceable with the displaceable roof section 3. Furthermore, this separation of the rear window 15 from the displaceable roof

section 3 was considered to be essential by Breitschwerdt et al. in order to enable the opening of the rear trunk lid 18 when the displaceable roof section 3 is disposed in its rearward-most position. See col. 4, lines 3-8 and dependent claim 9. Thus, Breitschwerdt et al. further teach away from, e.g., the features of claim 19, as the displaceable roof section 3 of Breitschwerdt et al. does not include a longitudinally-displaceable rear window 15.

In addition or in the alternative, it should be noted that Breitschwerdt et al. expressly teach away from utilizing a forward roof part in accordance with the present invention. In particular, at col. 1, ll. 17-20, Breitschwerdt et al. state “the present invention is concerned with the task of providing a passenger motor vehicle with a rigid roof which enables an open drive by the occupants without having to remove the roof or parts thereof.” (Emphasis added) See also, col. 2, ll. 4-7 of Breitschwerdt et al. Consequently, by teaching away from the use of removable roof parts, Breitschwerdt et al. would not have motivated a person of ordinary skill to develop an embodiment falling within the scope of the present claims.

In addition or in the alternative, it is noted that Breitschwerdt et al. do not teach or suggest a tailgate according to the amendment of claim 27. Thus, claim 27 is believed to be non-obvious for this additional or alternative reason.

In summary, it is believed that it would not have been obvious to modify Breitschwerdt et al. in the manner suggested by the Examiner and thus, it is respectfully requested to withdraw the rejection under Section 103(a) against claims 10, 19 and 27.

However, in case the Examiner is still not persuaded, it is requested to consider the following additional arguments. Even if the person of ordinary skill in the art, hypothetically speaking, would have been motivated to modify Breitschwerdt et al., King et al. does not provide all elements of claims 10, 19 and 27 missing from Breitschwerdt et al. Specifically, King et al. does not disclose a forward roof part that is attachable to a movable rear roof part and adjacent to the windshield frame. Rather, the lift off roof panel 18 of King et al., which attaches to the stationary A-pillar 20 and thus the windshield frame of the vehicle, is only attachable to a stationary B-pillar 22. The lift off roof panel 18 does not attach to the movable targa bar 24. In the alternative, the first tonneau cover 26 does not attach adjacent the windshield frame, but rather attaches to the B-pillar 22.

Moreover, it is noted that the lift-off roof panel 18 covers a fixed opening between the A- and B-pillars 20, 22. Therefore, this removable roof piece would not have a length that substantially corresponds to the length of the displacement path of a displaceable rear roof part.

Therefore, even if the skilled person were to have been motivated to combine Breitschwerdt et al. with King et al.(which Applicant vigorously disputes), this combination still fails to each all limitations of claims 10, 19 and 27. MPEP 2143.03. Consequently, the obviousness rejection should be withdrawn for this additional reason.

It is believed that the above-mentioned patentability arguments are fully persuasive and will result in withdrawal of the outstanding patentability rejections. However, it is also noted that King et al. has a US filing date of January 23, 2004 and an issue date of May 10, 2005. The present US national phase application has an International filing date (and thus an effective U.S. filing date) of February 10, 2005 and includes a valid Paris Convention priority claim to DE 10 2004 007 587.5, which was filed February 17, 2004. Thus, King et al. is only available pursuant to Section 102(e).

Therefore, as precautionary, independent and auxiliary ground for withdrawing the obviousness rejection based upon Breitschwerdt et al. and King et al., a declaration under Rule 131 by the sole inventor, Mr. Brockhoff, is filed herewith in order to antedate King et al. and have it removed as a prior art reference. It is noted that the Brockhoff declaration states that the specification, claims and drawings were reduced to text prior to January 23, 2004, thereby establishing a complete conception of the invention prior to the effective date of King et al. Because no substantive changes were made to that written description before filing the German priority application and the International patent application, which forms the basis of the present US national phase application, all subject matter of the pending claims was thus necessarily also conceived prior to January 23, 2004, because the pending claims are fully supported by this written description.

Reasonable diligence between January 23, 2004 and the constructive reduction to practice (i.e. the filing of the above-noted German priority application) are established by paragraphs 7-11 of the Brockhoff declaration.

Paragraph 3 of the Brockhoff declaration states that all acts of conception and constructive reduction to practice were carried out in Germany, a WTO country since January 1, 1995. See e.g., http://www.wto.org/English/thewto_e/whatis_e/tif_e/org6_e.htm.

Therefore, such inventive acts are eligible to establish prior invention. 35 U.S.C. §104.

In accordance with MPEP 2138.06, it is only necessary to establish reasonable diligence between the effective date of King et al. and the foreign priority application, a certified copy of which was previously communicated to the PTO as indicated by the Notice of Acceptance of Application under 35 U.S.C. 371 and 37 C.F.R. 1.495 mailed March 27,

2007. See also, 35 U.S.C. §119 (the filing of the German priority application “shall have the same effect” as a US application filed on the same date).

The period between February 17, 2004 (the German priority filing date) and February 10, 2005 (the International filing date, which is the effective US filing date – Art. 11(3) PCT and 35 U.S.C. §375(a)) is legally excused by the Paris Convention. Further, because the International application forming the basis for this US national phase application was properly filed and designated the US, the International application “shall have the effect of a regular [U.S.] application ... as of the international filing date, which date shall be considered to be the actual filing date in each designated State.” Art. 11(3) PCT.

Therefore, because the present invention was conceived prior to the effective date of King et al. and was constructively reduced to practice in a reasonably diligent manner, invention prior to January 23, 2004 has been established and King et al. is not available under 35 U.S.C. 102(e) in view of the present circumstances. Consequently, the obviousness rejection based upon Breitschwerdt et al. and King et al. may be withdrawn for this alternative, auxiliary reason.

Although it is believed that the above-noted arguments and evidence are sufficient to place the application into a condition for allowance, the following additional points are noted.

In paragraph 9 of the Office Action, claims 12-15 and 20-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Breitschwerdt et al. in view of King et al. and further in view of Gold.

In substantiating this rejection, the Examiner took the position that the person of ordinary skill would provide a pivotable rear window according to Gold in order to maximize interior storage space. However, as was discussed above, the interior storage space is necessarily bisected by the rear luggage space lid 18 of Breitschwerdt et al. Thus, replacement of the slidable rear window 15 of Breitschwerdt et al. with a pivotable rear window would not provide any additional interior storage space.

Therefore, the person of ordinary skill in the art would have had no motivation to combine Gold with Breitschwerdt et al. and King et al. in order to achieve an embodiment falling within the scope of claims 12-15 or 20-21 and the Section 103 rejection of these claims may be withdrawn.

Further, none of the cited references teach or suggest lowerable rear, side elements in accordance with amended claim 16. Therefore, it is believed that amended claim 16 defines additional inventive subject matter.

Moreover, in view of the fact that the rear trunk lid 18 is affixed to the vehicle chassis of Breitschwerdt et al., there would have been no motivation to provide a rear bench or rear seats in accordance with claim 21. In fact, in order to achieve an embodiment according to claim 21, a complete re-design of Breitschwerdt et al. would have been necessary, which would not have been obvious to a person of ordinary skill in the art.

The remaining dependent claims are believed to be patentable for apparent reasons and/or due to the patentability of one or more of the claims from which they depend.

Finally, in paragraphs 15 and 16 of the Office Action, it was stated that the Applicant has not filed drawings in this application. While the Examiner is correct that the Applicant did not personally submit drawings directly to the PTO when the US national phase was entered, the Notice of Acceptance of Application under 35 U.S.C. 371 and 37 C.F.R. 1.495 mailed March 27, 2007 indicates that a copy of the International application was received by the PTO, i.e. from the IB. Furthermore, this Notice of Acceptance also specifically indicates as being received "Drawings filed on 08/16/2006". Moreover, the PAIR page for the present application contains "WIPO Publication – Non-English Version" dated August 16, 2006, which WO publication includes the drawings for this application. It is noted that the drawings of this WO publication may be utilized in the present US national phase application without modification, as no German words are present in the drawings.

Therefore, it is requested to utilize the drawings of the WO publication, which were transmitted from the IB to the PTO as indicated in the Notice of Acceptance dated March 27, 2007 and which are readily available on the PAIR page for the present US national phase application.

Conclusion

Therefore, it is respectfully submitted that all claims pending in the present Application are in condition for allowance. Reconsideration and allowance of pending claims is therefore respectfully requested.

If the Examiner believes an interview, either telephonic or in person, will advance the prosecution of this matter, it is respectfully requested that the Examiner contact the undersigned at the Examiner's convenience.

Respectfully submitted,

A handwritten signature in black ink, consisting of a series of loops and curves, representing the name Mark A. Ussai.

Mark A. Ussai
Reg. No. 42,195

File No. 016382-9017

Michael Best & Friedrich LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, Wisconsin 53202-4108
215.822.9104